REMARKS

Claims 37-58 are pending in the present application. Claims 49-58 were previously withdrawn from consideration as drawn to a non-elected invention. By virtue of this response, claim 37 has been amended. No claims have been cancelled and no new claims have been added. Accordingly, claims 37-48 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Claim Rejections under 35 U.S.C. §102

Claims 37-44

Claims 37-44 stand rejected under 35 U.S.C §102(b) as allegedly anticipated by U.S. Patent No. 5,984,933 to Yoon ("Yoon"). With respect to independent claim 37, from which the remaining rejected claims depend, the Office Action relies upon element (2240) as support for a clip, and element (2241) for support that the clip is capable of penetrating tissue. Applicants disagree with this rejection.

In order for a reference to be a proper anticipatory reference, it must teach or disclose each and every element of the rejected claims. Here, claim 37 has been amended to more particularly point out that the "clip is configured to penetrate tissue upon release from the shaft." Even if the spherical knotting elements of Yoon could somehow be construed as "clips" as Applicants have described and claimed them (which Applicants do not concede), the spherical knotting elements of Yoon are not configured to penetrate tissue upon release from a shaft. Indeed, element (2241), which the Office Action relies upon in support of the clip being capable of penetrating tissue, is a locking lip for locking the two jaws of the spherical knotting element together. The locking lip itself does not render the spherical knotting element capable of penetrating tissue, and clearly the spherical knotting element of Yoon is not configured to penetrate tissue upon release from the shaft in any way. For at least this reason, a rejection of claim 37 (and claims 38-44 which depend therefrom) under 35 U.S.C. §102, cannot stand.

Claim Rejections under 35 U.S.C. §103

Claims 45, 46, and 48

Claims 45, 46, and 48 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Yoon as applied to claim 37 above, in view of U.S. Patent No. 5,524,630 to Crowley. Applicants disagree with this rejection.

Yoon was discussed in detail above with respect to claim 37, from which claims 45, 46, and 48 depend. Specifically, Applicants described how Yoon fails to teach a clip configured to penetrate tissue upon release from a shaft. Crowley, which is being relied upon for various visualization features, fails to cure this deficiency. For at least this reason, a *prima facie* case of obviousness with respect to claims 45, 46, and 48 cannot stand.

Claim 47

Claim 47 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Yoon and Crowley as applied to claim 45 above, in view of U.S. Patent No. 5,766,240 to Johnson ("Johnson"). Claim 45 was discussed just above, where it was noted that a *prima facie* case of obviousness has not been established. Specifically, Yoon and Crowley fail render claim 45 obvious for at least the reason that they fail to teach (either alone or in combination) a clip that is configured to penetrate tissue upon release from a shaft. Johnson, which is relied upon in support of a viewing element, fails to cure this deficiency. Accordingly, a *prima facie* case of obviousness with respect to claim 47 cannot stand.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

Although the present communication may include alterations to the claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application, without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby. Any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Additionally, any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as whole.

Applicants respectfully traverse each of the rejections and each of the assertions in the Office Action regarding what the prior art shows or teaches, even if not expressly discussed herein. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and

authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 578492000510. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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